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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,199	02/14/2002	Adrian Filipi-Martin	CHM03	3201
7590 McNair Law Firm, P.A. P.O. Box 10827 Greenville, SC 29603			EXAMINER FIELDS, COURTNEY D	
			ART UNIT 2137	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS		MAIL DATE 12/22/2006	DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/076,199	<b>Applicant(s)</b> FILIPI-MARTIN ET AL.	
	<b>Examiner</b> Courtney D. Fields	<b>Art Unit</b> 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-9 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 7-9 is/are allowed.
- 6) ☒ Claim(s) 13-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-3,7-9 and 13-18 have been currently amended.
2. Claims 4-6,10-12 and 19 have been cancelled.
3. Claims 1-3,7-9 and 13-18 are pending.

### ***Response to Arguments***

4. Applicant's arguments filed 11 October 2006 have been fully considered but they are not persuasive.

5. Referring to the rejection of claim 13, the Applicant contends that the prior art O'Brien et al. does not disclose nor teach receiving an electronic message from an email client that is created by a sender and addressed to a recipient. The Examiner respectfully disagrees and asserts that O'Brien et al. discloses a method for encrypting electronic messages wherein the sender creates an email message using the client software (i.e. client's email address) and sends the electronic message to the recipient. When the client is connected to the network and an electronic message is to be sent to a recipient who is in possession of a digital certification, the client software will retrieve the user's digital certificate over the network from a public address book associated with the groupware server. The retrieved digital certificate is then used to encrypt the mail message. The encrypted mail message is then placed in the outbox where subsequently it is, either automatically sent to the groupware server, via connection and network, or sent at a later time in response to a directive from the user. Therefore, the encrypted electronic message is sent to the recipient, without the need for the sender's email client to retrieve the sender's public key. (See Column 5, lines 8-19)

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O'Brien et al. further discloses if the recipient's certificate (public key) cannot be found online so that an electronic message can be encrypted or if the recipient does not hold a digital certificate, the sender will have to send the electronic message to the recipient in an unencrypted form. (See Column 6, lines 46-51)

6. Therefore, the rejection of claims 13-18 are maintained in view of the reasons above and in view of the reasons below.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 13-18 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Brien et al. (US Patent No. 6,990,578)

Referring to the rejection of claim 13, O'Brien et al. discloses a method for encrypting an electronic message from a sender to a recipient comprising the steps of:

receiving an electronic message from an email client that is created by a sender and addressed to a recipient (See Column 5, lines 3-7)

attempting to decrypt the sender's private key according to the sender's ID and password (See Column 5, lines 9-14)

retrieving the recipient's public key from a computer readable medium if the sender's private key is successfully decrypted encrypting the electronic message according to the recipient's public key (See Column 5, lines 14-15)

and forwarding the encrypted electronic message to the recipient for subsequent retrieval without the need for the sender's email client to retrieve the sender's public key or encrypt the message (See Column 5, lines 15-19)

Referring to the rejection of claim 14, O'Brien et al. discloses the claimed limitation wherein retrieving an encrypted private key associated with the sender encrypted according to the sender's password (See Column 5, lines 20-32)

receiving an access attempt input from the sender (See Column 5, lines 14-19)

and validating the access attempt according to the encrypted private key so that the electronic message is not encrypted unless the access attempt is valid (See Column 5, lines 46-62)

Referring to the rejection of claim 15, O'Brien et al. discloses the claimed limitation wherein a informing the sender that the public key associated with the recipient cannot be found so that electronic message cannot be encrypted and sending the electronic message to the recipient unencrypted (See Column 6, lines 46-51)

Referring to the rejection of claim 16, O'Brien et al. discloses the claimed limitation wherein receiving an encrypted electronic message from the sender addressed to the recipient (See Column 5, lines 9-14)

obtaining a private key associated with the recipient (See Column 5, lines 20-32)

for decrypting the encrypted electronic message from the sender to the recipient so that the recipient can receive and decrypt an encrypted message (See Column 6, lines 4-16)

Referring to the rejection of claim 17, O'Brien et al. discloses the claimed limitation wherein signing the electronic message with a digital signature associated with the sender (See Column 6, lines 35-51)

Referring to the rejection of claim 18, O'Brien et al. discloses the claimed limitation wherein for receiving an electronic message having a digital signature associated with the sender (See Column 5, lines 46-59)

and verifying the authenticity of the electronic message according to the digital signature so that the recipient is ensured that the electronic message truly originates from the sender (See Column 5, lines 60-67)

### ***Allowable Subject Matter***

9. Claims 1-3 and 7-9 are allowed.

### ***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney D. Fields whose telephone number is 571-272-3871. The examiner can normally be reached on Mon - Thurs. 6:00 - 4:00 pm; off every Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cdf

December 20, 2006

  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER